

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Number : 10/083,249 Confirmation No.: 8236
Applicant : Joseph GIORDANO, *et al.*
Filed : February 27, 2002
Title : SYSTEM AND METHOD FOR PROCESSING FINANCIAL TRANSACTIONS
TC/Art Unit : 3691
Examiner: Clement B. GRAHAM

Docket No. : 24124.000172
Customer No. : 21967

REQUEST FOR PRE-APPEAL BRIEF CONFERENCE

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Pursuant to the Pre-Appeal Brief Conference Pilot Program announced in the Official Gazette and in response to the Office Action (“Office Action”) mailed June 8, 2011, Applicant hereby requests a pre-appeal brief conference in the above-referenced case. No amendments are being filed with this request. Additionally, this request is being filed with a Notice of Appeal. Applicant respectfully requests that the members of the Pre-Appeal Brief Conference (“Conference”) allow all pending claims in view of the following remarks.

REMARKS / ARGUMENTS

These Remarks are responsive to the Office action mailed June 8, 2011 (“Office Action”). Applicant respectfully requests reconsideration of the rejection of claims 21, 23-24, 26, 52-58, 60-62, 64-66, 68-69 and 71 under 35 U.S.C. § 103(a) for at least the following reasons.

I. Pending Rejections

Claims 21, 23-24, 26, 52-58, 60-62, 64-66, 68-69 and 71 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,089,284 to Kaehler (“Kaehler”) in view of U.S. Patent No. 6,484,260 to Scott (“Scott”).

II. The Interview Conducted on November 3, 2011

Applicant’s undersigned representative conducted a telephonic interview with Examiner Graham and a Supervisor on November 3, 2011. During that interview, Applicant’s representative raised several issues regarding the outstanding Office Action. Examiner Graham and the Supervisor agreed to reconsider the rejections and stated that a new Office Action would likely be issued. Several follow-up phone calls to Examiner Graham have not been returned, and Applicant now submits this Request for Pre-Appeal Brief Conference.

III. The Rejection of the Claims Under 35 U.S.C. § 103(a) is Improper

A Final Office Action mailed on November 23, 2010 rejected the claims under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kahler in view of U.S. Patent No. 6,301,471 to Dahm (“Dahm”). Applicant submitted a response on April 22, 2011, which argued, in part, that there was no rationale to combine Kaehler with Dahm. *See* April 22, 2011 Response at 9. The most recent Office Action states that “Applicant’s arguments filed 4/22/2011 ha[ve] been fully considered but they are moot in view of new grounds of rejection.” *See* Office Action at 10. But the new grounds of rejection – under 35 U.S.C. § 103 based on a combination of Kaehler and Scott – fails for the exact same reasons.

Independent claim 21 recites, in part, “electronically enrolling a user into the transaction processing program.” As acknowledged by the Office, “Kaehler fails to explicitly teach electronically enrolling a user.” *See* Office Action, page 3. The Office Action relies on Scott to

teach this limitation. However, Applicant respectfully submits that the Office Action does not present a proper rationale to combine the references to achieve the claimed system and method, and thus has failed to set forth a *prima facie* case of obviousness.

The Office Action asserts that “it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings to Kaehler to include electronically enrolling a user taught by Scott in order to provide mobile subscribers who have been identified as being likely candidates for churning, to efficiently, visually and interactively, review and offer for a mobile service plan better meeting the subscriber’s needs.” *See* Office Action, page 3. Applicant respectfully submits that neither Kaehler nor Scott have anything to do with “churning” or “mobile devices” at all. In fact the Office Action sets forth the identical statement that it made in the November 23, 2010 Office Action regarding the combination of Kaehler and Scott.¹ Therefore, at a minimum, the current Office Action does not present *any* proper rationale for Kaehler to be combined with Scott.

Moreover, even assuming *arguendo* that the Office Action did present a proper statement regarding the combination of Kaehler and Scott, Applicant respectfully submits that nothing in the prior art, taken as a whole, suggests a desire or advantage to combine Kaehler and Scott. “In order to rely on a reference as a basis for rejection of the applicant’s invention, the reference must either be in the field of the applicant’s endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned.” *In re Oetiker*, 977 F.2d 1443, 1447, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). Here, The Office Action fails to explain *why* the art as a whole would suggest use of Scott’s “portable, hand-held personal identification device for providing secure access to a host facility [and] include[ing] a biometric trait of a user that is inieuq to the user and providing a biometric signal indicative of the sensed biometric trait in Kaehler’s system, which has nothing to do with “biometric sensor systems” at all. Accordingly, Applicant submits that Kaehler and Scott are nonanalogous art. None of the cited reference, nor the Office Action, provide any basis for combining a fuel dispensing system using a transponder

¹ Applicant notes that this statement is merely a holdover from the previous Office Action – directed to the combination of Kaehler and Dahm (which is no longer applied) – and in now way present a proper rationale to combine Kaehler with Scott, neither of which have relate to “churning” in any way at all.

with a biometric personal identification system. Thus, Appellants submit that the Office's assumption is clearly improper.

Under 35 U.S.C. § 103, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988). There are four separate factual inquiries to consider in making an obviousness determination: (1) the scope and content of the prior art; (2) the level of ordinary skill in the field of the invention; (3) the differences between the claimed invention and the prior art; and (4) the existence of any objective evidence, or "secondary considerations," of non-obviousness. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966); *see also KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (2007). An "expansive and flexible approach" should be applied when determining obviousness based on a combination of prior art references. *KSR*, 127 S. Ct. at 1739. However, a claimed invention combining multiple known elements is not rendered obvious simply because each element was known independently in the prior art. *Id.* at 1741. Rather, there must still be some "reason that would have prompted" a person of ordinary skill in the art to combine the elements in the specific way that he or she did. *Id.*; *In re Icon Health & Fitness, Inc.*, 496 F.3d 1374, 1380 (Fed. Cir. 2007). Also, modification of a prior art reference may be obvious only if there exists a reason that would have prompted a person of ordinary skill to make the change. *KSR*, 127 S. Ct. at 1740-41.

For the reasons set forth above, the Office Action has failed to set forth a *prima facie* case of obviousness. For at least the reasons discussed above, the obviousness rejection for claim 21 is improper and should be withdrawn. All other pending claims are also rejected under 35 U.S.C. § 103(a) based on the combination of Kaehler and Scott. Applicant respectfully submits that the rejections of such claims is also improper for the same reasons as discussed above.

CONCLUSION

Accordingly, rather than proceeding with an expensive appeal, Applicant respectfully requests that the Office either refine its position or indicate its intention to allow an appeal to proceed. As a result, a appeal on that basis will certainly succeed, but the time and expense in preparing an appeal brief on that issue should not be borne by Applicant when the grounds provided in the Office Action are so clearly improper.

It is believed that all necessary fees are being charged for filing this Response. However, the Director is hereby authorized to treat any current or future reply, requiring a petition for an extension of time for its timely submission as incorporating a petition for extension of time for the appropriate length of time. Applicant also authorized the Director to charge all required fees, fees under 37 C.F.R. § 1.17, or all required extension of time fees, to the undersigned's Deposit Account No. 50-0206.

Respectfully submitted,

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